

### **REMARKS**

Claims 1-15 are all of the claims presently pending in the application. Applicant has amended claims 1 and 4 to define the claimed invention more particularly.

It is noted that the claim amendments are made only for more particularly pointing out the invention, and not for distinguishing the invention over the prior art, narrowing the claims or for any statutory requirements of patentability. Further, Applicants specifically state that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Claims 1 and 4 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Claims 10-14 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Claims 1-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gohda (U.S. Publication No. 2002/0154226) in view of Pruett, et al. (U.S. Patent No. 5,778,389; hereinafter "Gohda").

These rejections are respectfully traversed in the following discussion.

#### **I. THE CLAIMED INVENTION**

The claimed invention (e.g., as defined by exemplary claim 1) is directed to a computer-readable storage medium tangibly embodying a program of recordable, computer-readable instructions executable by a digital processing apparatus.

The program of recordable, computer-readable instructs the digital processing apparatus to perform, when a file stored in a first folder is selected to be stored into a second folder, comparing a filename of the selected file with a filename of each file already stored in the second folder, if the second folder contains no file having a filename same as the selected

file, storing the selected file into the second folder, if the second folder contains a file having a filename same as the selected file, displaying thumbnail images and file information of the selected file and the file having the same filename together on a display device and if the second folder contains a file having a filename same as the selected file, asking a user whether to overwrite the file of the second folder (e.g., see Application at paragraph [0033]).

Accordingly, the claimed invention provides a file transfer program that allows users to easily decide at a glance whether a file should overwrite another file and improves the operability of file transfer in the processing of multimedia files with personal computers.

## II. THE INDEFINITESS REJECTION

The Examiner has rejected claims 1 and 4 under 35 U.S.C. § 112 as allegedly being indefinite. Specifically, the Examiner alleges that claims 1 and 4 recite omnibus claims. The Examiner, however, is clearly incorrect.

That is, claim 1 (and similarly claim 4) previously recited, “*A computer-readable medium tangibly embodying a program of recordable, computer-readable instructions executable by a digital processing apparatus to perform a method of transferring files, the method comprising:....*”

The claimed invention is directed to a program tangibly embodied on a computer readable medium for performing a method. The claim then recites the steps associated with that method. Applicant submits that this is a common claim (e.g., *Beauregard* claim) format associated with a computer-readable medium.

Applicant submits that an omnibus claim is a claim including a reference to the description or the drawings without stating explicitly any technical features of the product or

process claimed. Indeed, an example of an omnibus claim, as provided in M.P.E.P. § 2173.05, is: A device substantially as shown and described in Figure 1.

Claims 1 and 4 clearly do not recite omnibus claims.

Applicant, however, merely in an effort to speed prosecution, has amended claim 1 (and similarly claim 4) to recite, *inter alia*, “A computer-readable storage medium tangibly embodying a program of recordable, computer-readable instructions executable by a digital processing apparatus, the program of recordable, computer-readable instructions instructing the digital processing apparatus to perform: ...”

Accordingly, Applicant respectfully requests the Examiner to reconsider and withdraw this rejection.

### **III. THE STATUTORY SUBJECT MATTER REJECTION**

The Examiner has rejected claims 10-14 under 35 U.S.C. § 101 as being directed to a program per se. The Examiner, however, is incorrect.

First, Applicant submits that the Examiner’s rejection is vague. Specifically, the Examiner states that claims 10-14 are rejected. The body of the rejection, however, discusses claims 1 and 4 instead of rejected claims 10-14.

Applicant pointed out this deficiency in the Office Action to the Examiner on June 13, 2008. Since the error in the Office Action was brought to the attention of the Examiner within one month of the mailing date of the Office Action, the Examiner is required to correct the error in a new non-final Office Action.

Notwithstanding the above, Applicant submits that neither claims 1 and 4 nor claims 10-14 recite a computer program per se.

M.P.E.P. § 2106.01 defines “functional descriptive material.” Specifically, “[i]n this context, “functional descriptive material” consists of data structures and computer programs which impart functionality when employed as a computer component.” (M.P.E.P. § 2106.01).

Applicants respectfully submit that the claimed invention of claims 1 and 4 recites “[a] *computer-readable medium tangibly embodying a program of recordable, computer-readable instructions executable by a digital processing apparatus to perform a method of transferring files, the method comprising:....*” Therefore, even if the claimed invention of claims 1 and 4 recited functional descriptive material, the material is recorded on a computer-readable medium and is therefore structurally interrelated to the medium and constitutes statutory subject matter.

Moreover, with respect to claims 10-14, the claimed invention clearly recites a system including physical components.

The claimed invention (of claims 1, 4, and 10-14) is not directed to data structures as alleged by the Examiner. Indeed, the definition of “data structure” is “a physical or logical relationship among data elements, designed to support specific data manipulation functions” (see M.P.E.P. § 2106.01). The claimed invention of claims 10-14 recites a computer system comprising a plurality of physical components.

Accordingly, Applicant respectfully requests the Examiner to reconsider and withdraw this rejection.

#### **IV. THE PRIOR ART REFERENCES**

The Examiner alleges that one of ordinary skill in the art would have combined Gohda with Pruett to render obvious the claimed invention of claims 1-15. Applicant submits,

however, that, even if combined, the alleged combination of references would not teach or suggest each and every feature of the claimed invention.

That is, the alleged combination of references does not teach or suggest, “*if the second folder contains a file having a filename same as the selected file, displaying thumbnail images and file information of the selected file and the file having the same filename together on a display device*”, as recited in claim 1, and somewhat similarly recited in claims 5 and 10.

Applicant respectfully submits that, in rejecting claims 1-15, the Examiner is merely picking and choosing portions of the disclosure of Gohda and Pruett, taken out of context, and attempting to piece together the selected portions to arrive at the claimed invention.

For example, the Examiner alleges, “Pruett teaches the claimed, if the second folder contains a file having a filename same as the selected file.” (See Office Action dated May 14, 2008 at page 5). Applicant submits, however, the Examiner is merely selecting portions of a claim limitation and attempting to find somewhat analogous terminology in the applied references without considering the plain meaning of the claimed invention nor the context from which the allegedly analogous terminology is taken from in the reference. Indeed, the Examiner’s allegation, quoted above, is not even a complete sentence. It is merely a portion of a claim limitation, which has been removed from his context completely.

That is, in the claimed invention if the second folder contains a file having a file name that is the same as the selected file, then the system displays thumbnail images and file information of the selected file and the file having the same filename together on a display device.

In stark contrast, Pruett teaches determining whether a selected file from a source directory has the same name as a file already existing in a target directory (see Pruett at

column 6, lines 27-33). If the selected file has the same name as the file in the target directory, then Pruett teaches that the file from the source directory is merely not copied into the target file (see Pruett at column 6, lines 47-48).

Furthermore, Gohda merely teaches that the processor may display thumbnail images on a monitor (see Gohda at paragraph [0094]). Gohda, however, does not teach or suggest displaying thumbnail images in the context of the claimed invention. Indeed, Gohda does not teach or suggest displaying thumbnail images and file information of the selected file and the file having the same filename together on a display device. Indeed, Gohda does not teach or suggest displaying file thumbnail images and file information together. Furthermore, Gohda does not teach or suggest displaying thumbnail images of the selected file and the file having the same filename together on a display device.

Thus, the alleged combination of references does not teach or suggest each and every feature of the claimed invention.

Moreover, the alleged combination of references does not teach or suggest, “*displaying an icon image on a display device, the icon image indicating that the file comprises audio, for the selected file and an audio file stored in the second folder; and playing back the audio upon operation to the icon image*”, as recited in exemplary claim 4.

In rejecting claim 4, the Examiner alleges, “Gohda teaches the claimed, displaying an icon image on a display device, the icon image indicating that the file is audio, for the selected file and an audio file stored in the second folder (Fig. 7, page 5, paragraph [0089]). Gohda teaches the claimed “to play back the audio upon operation to the icon image”. (See Office Action dated May 14, 2008 at page 6).

Gohda, however, merely teaches a moving image decoding/encoding module (see

Gohda at paragraph [0089]). Gohda, however, does not teach or suggest indicating that a displayed image is an audio file. Furthermore, Gohda does not teach or suggest playing back the audio upon operation of the icon image. Indeed, Gohda does not even mention an audio file (see Gohda at paragraph [0089]).

Moreover, Applicant submits that Gohda does not teach or suggest, *“if the second folder contains a file having a filename same as the selected file, asking a user whether to overwrite the file of the second folder”*, as recited in exemplary claim 1, and similarly recited in exemplary claim 4.

The alleged combination of references does not teach or suggest asking a user whether to overwrite a file in second folder.

Indeed, the Examiner concedes that Gohda does not even teach or suggest checking whether the same name exists on the second folder, let alone teach or suggest asking a user whether to overwrite a file in second folder.

Furthermore, Pruett discloses, “[i]f the contents are identical, then there is no need to copy the contents of the source file into the target file.” (See Pruett at column 6, lines 47-48). Accordingly, Pruett does not give the user the choice of overwriting the file in the second folder, as recited in the claimed invention.

Therefore, Applicant submits that, even if combined, the alleged combination of references would not teach or suggest each and every feature of the claimed invention. Accordingly, Applicant respectfully requests the Examiner to reconsider and withdraw this rejection.

Serial No. 10/733,380 14  
Docket No. FJ-2003-046-US  
(MAS.018)

**V. FORMAL MATTERS AND CONCLUSION**


In view of the foregoing, Applicant submit that claims 1-15, all of the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. Applicant respectfully requests the Examiner to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, Applicant requests the Examiner to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The undersigned authorizes the Commissioner to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Date: August 13, 2008

Respectfully Submitted,



\_\_\_\_\_  
Scott M. Tulino, Esq.  
Registration No. 48,317

Sean M. McGinn, Esq.  
Registration No. 34,386

**MCGINN INTELLECTUAL PROPERTY  
LAW GROUP, PLLC**  
8321 Old Courthouse Road, Suite 200  
Vienna, VA 22182-3817  
(703) 761-4100  
**Customer No. 21254**